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David Gang

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EXAMINER

WALSH, JOHN B

ART UNIT

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2151

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/715,210	Applicant(s) GANG ET AL.	
	Examiner John B. Walsh	Art Unit 2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on amdt of 1/28/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1- 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 25 and 26 recite “separating the embedded...object from the electronic message” and then recites “delivering the electronic message to the destination with an unaltered viewable version of the separated multimedia object.” It is unclear if the object is delivered in the message, and if this is the case it is further unclear since the previous step has separated the object from the message. An alternative interpretation would be that the object is not delivered inside the message but separate.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 26 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 26 is drawn to a system comprising means for identifying, means for separating, means for delivering and means for enabling. The specification at page 14, lines 29-30 disclose the system maybe implemented in software alone. Therefore claim 26 covers an embodiment, i.e. software, that is non-statutory subject matter.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-13, 15-17, 19 -22, 25 and 26 as best understood are rejected under 35

U.S.C. 102(e) as being anticipated by U.S. PGPUB 2002/0016818 to Kirani et al.

As concerns claims 1, 25 and 26, automatically saving communicated multimedia objects to a repository for subsequent use, comprising: identifying an incoming or outgoing electronic message intended for a destination (abstract; email), identifying an embedded multimedia object embedded within the identified electronic message or an attached multimedia object attached within the identified electronic message (abstract; email attachments); separating the embedded multimedia object or the attached multimedia object from the electronic message (abstract; attachments removed from messages); delivering the electronic message to the destination with an un-altered, viewable version of the separated multimedia object (0101) and automatically saving the un-altered, viewable version of the separated multimedia object to a repository (abstract; saved in repository) for subsequent use by a user; and enabling the user to select the multimedia object from the repository for subsequent use (abstract; accessed via link).

As concerns claim 2, wherein the repository includes a central repository (abstract; network media-sharing repository).

As concerns claim 3, wherein the repository includes a local repository (network repository can be interpreted as a local repository; 0050-device has its own repository/memory as well).

As concerns claim 4, determining a type of the multimedia object; and automatically saving the multimedia object to the repository based on the determination of the type of the multimedia object (abstract; size and type; size of object is equivalent to a "type"; figure 5a, 503).

As concerns claim 5, determining a type of the multimedia object (abstract); and automatically not saving the multimedia object to the repository based on the determination of the type of the multimedia object (0040; valid objects).

As concerns claim 6, wherein the type of the multimedia object includes a non-picture image (0006).

As concerns claim 7, wherein the non-picture image includes an emoticon (0006).

As concerns claim 8, wherein the multimedia object includes an image (0006).

As concerns claim 9, wherein the image includes a picture (0006).

As concerns claim 10, wherein the multimedia object includes a music file (0006).

As concern claim 11, wherein the multimedia object includes a video file (0006).

As concerns claim 12, wherein enabling the user to select the multimedia object from the repository for subsequent use includes enabling the user to send the multimedia object to other users using a graphical user interface (figure 2; 215).

As concerns claim 13, wherein enabling the user to select the multimedia object from the repository for subsequent use includes enabling the user to send the multimedia object to others

(0040) across multiple applications using a graphical user interface (figure 2; 215) that is common to the multiple applications.

As concerns claims 15 and 19, wherein the multiple applications include a member directory (0040; recipients address, 0093).

As concerns claims 16 and 20, wherein the multiple applications include a web page publishing application (figure 2; 201c).

As concerns claim 17, wherein the automatically saved multimedia object is available for use across multiple applications using a graphical user interface (figure 2; 215) that is common to the multiple applications.

As concerns claim 21, wherein the incoming or outgoing electronic message includes electronic mail (abstract).

As concerns claim 22, wherein enabling the user to select the multimedia object from the repository for subsequent use includes enabling the user to select and use the multimedia object in multiple applications without having to upload the multimedia object to the repository (abstract; access via URL).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 14 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

PGPUB 2002/0016818 to Kirani et al. as applied above in view of U.S. PGPUB 2002/0184309.

Kirani et al. '818 disclose applications (201).

Kirani et al. '818 do not explicitly disclose the application is an instant messaging application.

Danker et al. '309 teach an instant messaging application (figure 4).

It would have been obvious to one having ordinary skill in the art at the time of the invention to provide Kirani et al. '818 with an instant messaging application, as taught by Danker et al. '309, in order to provide a quicker means of communicating with multiple users. One of ordinary skill in the art would have made such a modification since it is a combination of known elements that yields predictable results.

9. Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. PGPUB 2002/0016818 to Kirani et al. as applied above in view of U.S. Patent No. 6,856,999 to Flanagan et al.

Kirani et al. '818 do not explicitly disclose determining whether the multimedia object is stored in the repository and saving or not saving based on the determination.

Flanagan et al. '999 teach saving/writing objects based on whether they have already been stored/written (abstract).

It would have been obvious to one having ordinary skill in the art at the time of the invention to provide system of Kirani et al. '818 with storage determination, as taught by Flanagan et al. '999, in order to provide a means of preventing redundant data being stored and wasting storage space.

Response to Arguments

10. Applicant's arguments filed January 28, 2008 have been fully considered but they are not persuasive. The applicant argues Kirani fails to disclose the limitations of claim 1. The

limitations of claim 1 argued by the applicant have rendered the claims unclear and indefinite and the claims have been rejected as best understood. The claim scope presently covers wherein the object/attachment is separated from the message and delivered separately from the message, which is anticipated by Kirani.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892; USPN 7,257,639.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John B. Walsh whose telephone number is 571-272-7063. The examiner can normally be reached on Monday-Thursday from 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John B. Walsh/
Primary Examiner, Art Unit 2151